

REMARKS

Claim 29-38, presented hereby in place of claims 18-28, cancelled hereby without prejudice or disclaimer, are pending.

Present generic claim 29 essentially combines the subject matter of first and second independent claims 18 and 28; i.e., claim 28 amended to contain the feature (limitation) “wherein the microporous heat insulation body *does not contain organic components in a substantial amount.*” (*emphasis added*). Present dependent claims 30-38 correspond to dependent claims 19-27, revised to depend on present claim 29.

Applicants wish to thank Examiner Patricia Nordmeyer for the courteous consideration rendered to applicants’ representative during a telephone interview on 6 August 2003. Combining subject matter of claims 18 and 28, as in present claim 29, was discussed during the interview. As explained below, the subject matter of present claim 29 (and, so, of dependent claims 30-38) is patentable over the art relied on in the rejections of record.

Claims 18-21, 24, and 25 were rejected under 35 USC 103(a) for alleged obviousness based on the combined teachings of U.S. Patent No. 5,556,689 (Kratel) and U.S. Patent No. 4,783,365 (Sklarski). Claims 22 and 23 were rejected for alleged obviousness under 35 USC 103(a) based on the combined teachings of Kratel, Sklarski, and U.S. Patent No. 4,647,449 (Takahashi). Claim 26 was rejected for alleged obviousness under 35 USC 103(a) based on the combined teachings of Kratel, Sklarski, and U.S. Patent No. 4,381,327 (Briers). Claim 27 was rejected for alleged obviousness under 35 USC 103(a) based on the combined teachings of Kratel, Sklarski, and U.S.

Patent No. 5989371 (Nishimoto). Claim 28 was rejected for alleged obviousness under 35 USC 103(a) based on the combined teachings of Kratel, Sklarski, and U.S. Patent No. 5741608 (Kojima). The subject matter of claims 1-7 was provisionally rejected for alleged obviousness-type double patenting over claims 1-4 of copending application no. 09/857,181. Reconsideration of the rejections under §103(a) and the rejection for obviousness-type double patenting is requested in view of the changes to the claims effected, hereby.

Only one of the pending rejections of record under §103(a) was applied against claim 28, as indicated above, i.e., the rejection based on the combined teachings of Kratel, Sklarski and Kojima. In that all of the present claims are limited to the subject matter of claim 28, the other pending rejections of record under §103(a) are rendered moot by the instant amendment. The pending rejection for alleged obviousness-type double patenting is also rendered moot by the instant amendment, in that the subject matter of claim 28 was not included in the rejection.

As indicated, above, the present claims represent the microporous heat insulating body of claim 28 *absent* “organic components in a substantial amount.” According to the final rejection: “No mention of the absence of organic materials is made in the second independent claim [claim 28], and thereby the previous rejection is being maintained” (Office Action page 8). By implication, therefore, amending claim 28 such that the microporous heat insulating body “does not contain organic components in a substantial amount,” as represented in by present claim 29, would result in the rejection of claim 28 *not* being maintained.

In any event, as previously explained on the record (amendment filed May 5, 2003, page 5), Sklarski, relied on to reject claim 28, discloses an insulating structure comprising mica papers impregnated with large amounts of organic materials (e.g., Sklarski, Abstract). As such, combining the teachings of Kratel, Sklarski, and Kojima, as alleged in the statement of rejection, would have suggested to one skilled in the art an insulation body *that contains relatively large amounts of organic materials*.

In other words, the combined teachings of Kratel, Sklarski, and Kojima fail to disclose at least one limitation on the present claims, i.e., the limitation “wherein the microporous heat insulation body does not contain organic components in a substantial amount. Since a limitation on the present claims is absent from the references relied on in the statement of rejection, the rejection for alleged obviousness, under section 103(a) is not applicable against the present claims. *Royka, supra*.

As described in the present specification (page 3, paragraph 5), a heat insulation body should not contain organic or combustible components. This would destabilize the product upon heating and could also release toxic gases.

The mica sheet is described in Sklarski for use as an electrical insulator and the relatively high content of organic material is critical (and, certainly, not detrimental) to the use described. On the other hand, the high content of organics required in Sklarski is detrimental in accordance with a heat insulating body as presently claimed. The reference neither teaches nor suggests use of its mica sheet as a heat insulating material, let alone as presently claimed.

Therefore, even assuming, arguendo, there had been a motivation for one skilled in the art to combine Kratel with Sklarski and Kojima, the combination would not have effected the presently claimed invention.

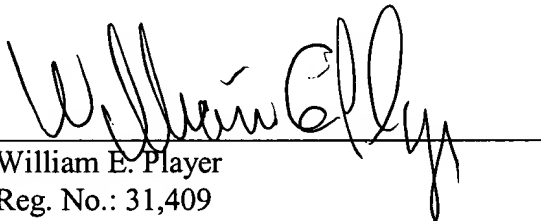
To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be found in the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Favorable action is requested.

Respectfully submitted,

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